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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10 040,405	01 09 2002	Kia Silverbrook	WSM010US	2054

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SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

SONG, SARAH U

ART UNIT PAPER NUMBER

2874

DATE MAILED: 07/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/040,405

Applicant(s)

SILVERBROOK, KIA

Examiner

Sarah Song

Art Unit

2874

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

2. The prior art documents submitted by the applicant in the Information Disclosure Statement filed on March 15, 2002 have all been considered and made of record (note the attached copy of form PTO-1449).

### ***Drawings***

3. This application has been filed with eighteen (18) sheets of drawings, which have been approved by the Examiner.

### ***Specification***

4. The disclosure is objected to because of the following informalities: on page 6, in line 12, "figure 20", both occurrences, should be changed to -figure 7-; in line 18, "actors" should be changed to -factors-.

Appropriate correction is required.

### ***Claim Objections***

5. Claims 1 and 12 objected to because of the following informalities: In claim 1, "the perimeter edge" and "the free edge" in line 5 lack proper antecedent basis. Examiner suggests -a perimeter edge—and -a free edge—for the first recitation of the noted elements. In claim 12, "the at least second region" lacks proper antecedent basis. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Han et al. (U.S. Patent 6,374,004). Han et al. discloses an optical fiber terminator package including:

a. A semiconductor chip 16 having a top surface and a bottom surface and including at least one first and second optical device 14 which emits or receives electromagnetic radiation at one or more wavelengths from the top surface;

b. A first hollow cap (15, 20 and 22) having a central portion (recess shown in Figure 2a) and a four perimeter walls extending from a perimeter edge of the central portion with a free edge of each perimeter wall bonded to the top surface to provide a first cavity which, in plan view, overlays at least part or all of at least one light emitting device, said central portion including:

i. At least one region (the central opening shown in Figure 2a or optical element 20) which is at least substantially transparent or translucent to electromagnetic radiation at said one or more wavelengths; and

c. Wherein the first cap has been bonded to the semiconductor chip 16 at the wafer stage prior to separation of the wafer into individual packages.

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The cap further includes first and second attachment means 24, 26 (one on each side of the central portion. Han et al. also discloses a second cap 18 bonded to the bottom surface of the chip 16, said second cap, in plan view, overlaying at least part or all of at least one first optical device. Regarding claim 11 and 12, see Figure 4a, which shows first and second regions that refract electromagnetic radiation passing therethrough. Note also claims 1-7, 9 and 10 of Han et al.

### ***Conclusion***

8. Any inquiry concerning the merits of this communication should be directed to Examiner Sarah Song at telephone number 703-306-5799. Any inquiry of a general or clerical nature, or relating to the status of this application or proceeding should be directed to the receptionist at telephone number 703-308-0956 or to the technical support staff supervisor at telephone number 703-308-3072.

*Sarah Song*  
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June 28, 2003

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